

### **REMARKS**

Claims 1-5, 7, 8, 12, 13, 16, 17, 22, 25, 26, and 80-102 are pending in the application and claims 1, 22, 80, 91, and 102 have been amended. No new matter has been added

The Examiner's remarks in the last Office Action are addressed below. It is believed that the amended claims and all dependent claims, taken in light of the remarks made herein, meet all criteria for patentability.

### **CLAIM REJECTIONS**

#### ***Rejection of claims under 35. U.S.C. §112, second paragraph***

The Examiner has rejected claims 80-90 for "failing to particularly point out and distinctly claim the subject matter which applicants regards as the invention. The Examiner points out that since claim 80 "does not recite what disease state is to be treated, [i]t is therefore impossible to determine the meaning of an 'an effective amount.'" Applicants respectfully traverse this rejection.

To expedite prosecution, and not in acquiescence to the rejection, Applicants have amended claim 80 to remove the phrase "an effective amount." Thus, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 80 and its dependents under 35 U.S.C. §112.

#### ***Rejection of claims under 35 U.S.C. §102(b)***

The Examiner has rejected claims 1-5, 7-8, 12-13, 16-17, 22, 25, 26, and 80-102 under 35 U.S.C. §102(b) as being anticipated by Jaeger et al. (*European Journal of Medicinal Chemistry*, (1993) 28:275-290). Applicants respectfully traverse this rejection.

The Examiner relies on Jaeger et al. as teaching

"compounds **92** and **93** which correspond to compounds of instant formula (1) wherein A = substituted and unsubstituted phenyl; Y<sup>1</sup>, Y<sup>2</sup>= a bond; L is a straight chain C<sub>8</sub> hydrocarbon with 4 double bonds in *trans* configuration substituted with methyl groups and X<sup>1</sup>, X<sup>2</sup>=O" and

"compound **120** which corresponds to a compound of instant formula (1) wherein A = C<sub>6</sub> cycloalkenyl; Y<sup>1</sup>, Y<sup>2</sup>= a bond; L is a straight chain C<sub>6</sub> hydrocarbon with 2 double bonds in *trans* configuration substituted with a methyl group and X<sup>1</sup>, X<sup>2</sup>=O."

The Examiner further states that since Jaeger et al. discloses "the use of  $10^{-8}$  molar solutions (pharmaceutical compositions) for treating keratinized cell cultures", Jaeger therefore anticipates claims 1-5, 7-8, 12-13, 16-17, 22, 25, 26, and 80-102.

To anticipate a claim, a reference must teach each and every element of the claim. Amended claims 1, 22, 80, 91 and 102 recite a compound of formula (I) wherein "... L is a straight  $C_{3-12}$  hydrocarbon chain optionally containing at least one double bond, at least one triple bond, or at least one double bond and one triple bond; said hydrocarbon chain being optionally substituted with  $C_{2-4}$  alkenyl,  $C_{2-4}$  alkynyl,  $C_{1-4}$  alkoxy, hydroxyl, halo, amino, nitro, cyano,  $C_{3-5}$  cycloalkyl, 3-5 membered heterocycloalkyl, monocyclic aryl, 5-6 membered heteroaryl,  $C_{1-4}$  alkylcarbonyloxy,  $C_{1-4}$  alkyloxycarbonyl,  $C_{1-4}$  alkylcarbonyl, or formyl; and further being optionally interrupted by -O-, -N(R<sup>c</sup>)-, -N(R<sup>c</sup>)-C(O)-O-, -O-C(O)-(R<sup>c</sup>)-, -N(R<sup>c</sup>)-C(O)-N(R<sup>d</sup>)-, or -O-C(O)-O- ..."

Jaeger et al. describes compounds having methyl substituents between a cyclic moiety and a carbonyl group. Thus, independent claims 1, 22, 80, 91, and 102 as amended and dependent claims thereof, are not anticipated by compounds described by Jaeger et al.

Jaeger et al. does not describe pharmaceutical compositions. Rather, the reference describes the use of aqueous solutions, not a compound of formula (I) and a pharmaceutically acceptable carrier.

Accordingly, because Jaeger et al. does not teach each and every element of claims 1-5, 7-8, 12-13, 16-17, 22, 25, 26, and 80-102, Applicants respectfully request reconsideration and withdrawal of these rejections under 35 U.S.C. §102(b).

### **CONCLUSION**

For the foregoing reasons, Applicants respectfully request reconsideration and withdrawal of the pending rejections. Applicants believe that the claims now pending are in condition for allowance.

Should any fees be required by the present Amendment, the Commissioner is hereby authorized to charge Deposit Account **19-4293**.

Applicant : Hsuan-Yin Lan-Hargest et al.  
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If, for any reason, a telephonic conference with the Applicant would be helpful in expediting prosecution of the instant application, the Examiner is invited to call Applicants' Attorney at the telephone number provided below.

Respectfully submitted,



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